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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,693	12/17/2001	Werner P. Schlecht	32164-176676	6292

7590 02/14/2003

VENABLE

Post Office Box 34385

Washington, DC 20043-9998

EXAMINER

GUTMAN, HILARY L

ART UNIT

PAPER NUMBER

3612

DATE MAILED: 02/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/015,693

Applicant(s)

Schlecht et al.

Examiner

Hilary Gutman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 15, 2003
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above, claim(s) 16-19 and 32-65 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 20-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Dec 17, 2001 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 & 3
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Election/Restriction

1. Applicant's election without traverse of invention I (claims 1-31) and species A (Figure 5) and species E (Figure 9) in Paper No. 7 is acknowledged.
2. Claims 16-19 and 32-65 are hereby withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 7.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "12" has been used to designate both rear window windup shade and straight outlet slit in Figure 1.
5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "9" has been used to designate both rear window shelf and rear window pane.

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6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: trunk "3" is not shown in the figures.

7. The drawings are objected to because:

- In Figure 2 reference number "25" should be "26".

- In Figure 3 reference number "12" should be "19".

- In Figure 10, reference number 78 is not pointing to the fold but is instead incorrectly pointing to the flange 79.

- In Figure 12 the lead line for reference number "22" should be pointing to the slit.

8. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "door" and "body" of claim 31 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

9. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

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Specification

10. The following guidelines illustrate the preferred layout and content for patent applications. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

The following order or arrangement is preferred in framing the specification and, except for the reference to the drawings, each of the lettered items should appear in upper case, without underling or bold type, as section headings. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) Title of the Invention.
- (b) Cross-Reference to Related Applications.
- © Statement Regarding Federally Sponsored Research or Development.
- (d) Reference to a "Sequence Listing," a table, or a computer program listing appendix submitted on compact disc (see 37 CFR 1.52(e)(5)).
- (e) Background of the Invention.
 - 1. Field of the Invention.
 - 2. Description of the Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) Brief Summary of the Invention.
- (g) Brief Description of the Several Views of the Drawing(s).
- (h) Detailed Description of the Invention.
- (I) Claim or Claims (commencing on a separate sheet).
- (j) Abstract of the Disclosure (commencing on a separate sheet).
- (k) Drawings.
- (l) Sequence Listing, if on paper (see 37 CFR 1.821-1.825).

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11. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are:

- On page 2, line 2, "claim 1" and line 3, "claim 32" are disclosed in the specification which is inappropriate language for the specification and should be modified or deleted altogether.

- On page 4, line 31, "dependent claims" are disclosed which is inappropriate language for the specification.

- On page 6, line 4, "pane 9" is disclosed but in the figures number 9 is used to represent the shelf. Also on line 5, "shelf 11" is disclosed but in the figures number "11" is used to represent the slit. On line 8, "slit 12" is disclosed but reference number 12 is also used to represent the rear window windup shade. Corrections should be made in either all instances throughout the specification, in the drawings, or in both the spec and drawings, for consistency and clarity throughout.

On page 7, line 23, "opening" should be inserted after "window".

On page 8, lines 3-4, "At 34, its outer end" should be "An outer end 34". On line 17, "(direct current)" should be inserted after "d.c.".

On page 9, line 1, "cylindrical" should be inserted after "flexible". On line 14, "hose-like" should be "hose-shaped". On lines 14-15, "guide members 29, 30" were previously disclosed at page 7, line 35 as "end pieces 29 and 30" and only one reference number should be used for one

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item of the invention for clarity. This conflicting terms for the reference numbers should be modified for consistency throughout the specification. Also on line 20, "shade 13" should be "shade 12".

On page 10, line 5, "legs 32" should be "arms 32". On line 20, "two guide members" should be "two thrust members". On line 32, "motor vehicle" should be "passenger car".

On page 11, line 16, "element 61" was previously "leg 61" and should be modified in all instances. On line 33, "respective guide rail elements 66" should be "first section 66 of the guide rail 13".

On page 12, line 12, the phrase "threaded" into piece 66 is unclear as to how this threading is accomplished since this feature is not apparently shown in the figures. Also on line 12, "piece" should be "first section".

On page 13, line 11 there is an extra period after "Fig. 5" which should be deleted. On line 12, it is unclear what the section 67 is "hinged on" since the sentence is incomplete. In addition, on line 12, "bolt 72" should be "pin 72". On line 19, "flange" should be "leg".

On page 14, lines 29 and 31, "opening" should be inserted after "window". On line 33, "fold 79" should be "fold 80".

On page 15, lines 11-12, "rivets, as schematically indicated at 83." should be "rivets 83.". On line 20, "fold 81" should be "fold 80". On line 35, "flange 78" should be "flange 79".

On page 16, line 11, "side 14" should be "walls 15, 16". On line 15, "surface 15" was previously "wall" 15 and should be modified for clarity. On line 19, "inner flange 81" should be

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"flange 81 of the inner shaped sheet metal element 77". On line 22, "flange 78" was previously "fold 78" and should be modified. Also on line 22, "pushed with" is unclear and awkward language.

On page 17, line 16, "is" should be inserted before "placed". On lines 19 and 20, "flange" should be "leg". On line 25, "elements" should be "brackets" (both occurrences). On line 29, "ends" should be "end pieces" and "rail" should be "rails,". On line 30, "elements," should be deleted. Appropriate correction is required.

12. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

13. The abstract of the disclosure is objected to because: on line 6, "elements" should be "brackets" (both occurrences). On line 10, "ends" should be "end pieces". On lines 10-11, "rail elements," should be "rails,". Correction is required. See MPEP § 608.01(b).

Claim Objections

14. Claims 11 and 12 are objected to because of the following informalities:

- In claim 11, on line 4, "in respect" should perhaps be "with respect".
- In claim 12, on line 4, "in respect" should perhaps be "with respect".

Appropriate correction is required.

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Claim Rejections - 35 USC § 112

15. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

16. Claims 1-15 and 20-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claim 1, “seating”, “connecting”, and “guide” means are all recited. It should be noted that if one employs means plus function language in a claim, one must set forth in the specification and adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112.

Claim 1 recites the limitations "the extended window shade web" in lines 14-15 and “the guide rails” in line 21. There is insufficient antecedent basis for these limitations in the claim.

In claim 1, line 9, the phrase “and/or” is vague and indefinite and inappropriate language for the claim. Perhaps the applicant should instead state “wherein at least one of the seating means and the connecting means are arranged to be attached to the motor vehicle”.

In claim 1, line 14, the phrase “a piece away from the side next to the...web” is unclear as to what feature of the invention “a piece away” is referring.

• Claim 5 recites the limitation "the mounting flange" in line 2. . There is insufficient antecedent basis for this limitation in the claim.

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In claim 5, line 4, the phrase “and/or” is vague and indefinite and inappropriate language for the claim. Perhaps the applicant should instead state “in at least one of a material-to-material and interlocking connection”.

Claim 6 recites the limitation “the window” in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 8 recites the limitation “a guide rail” in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

Claim 9 recites the limitations “the associated edge” in line 3 and “the window” in line 3. There is insufficient antecedent basis for these limitations in the claim.

Claim 10 recites the limitation “the guide rail” in line 2. There is insufficient antecedent basis for this limitation in the claim. Also in claim 10, line 4, “and/or” is recited which is inappropriate language for the claim.

Claim 12 recites the limitation “the guide rail” in lines 2 and 5. There is insufficient antecedent basis for this limitation in the claim.

Claim 13 recites the limitations “its side” in line 2 and “the groove slit” on line 2. There is insufficient antecedent basis for these limitations in the claim. Also in claim 13, line 4, “and/or” is recited which is inappropriate language for the claim.

Claim 14 recites the limitations “each guide rail” in line 2, “the first one” in line 3, “it” in line 5, “the ends” in line 6, and “the completely retracted position” in line 7. There is insufficient antecedent basis for these limitations in the claim. Perhaps “the first one” should be “the first

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section. In addition, it should be noted that although “the window shade web” does not lack antecedent basis in the claim, since reference number “(12)” is used to represent the feature perhaps the applicant intended to recite simply the “window shade” and not specifically the “web” itself. In this case perhaps “web” should be deleted on line 7. However, if this is not the case the reference number in parenthesis following “web” should be changed to the correct corresponding number “(26)” for clarity. Finally, it should be noted that none of the previous claims appear to recite that either the “web” or the “shade” has a “completely retracted position”.

Claim 15 recites the limitations “it” in line 3, “the total length” in line 3, “the window shade web” in lines 4-5, and “the retracted position” on line 5. There is insufficient antecedent basis for these limitations in the claim. In addition, it should be noted that although “the window shade web” does not lack antecedent basis in the claim, since reference number “(12)” is used to represent the feature perhaps the applicant intended to recite simply the “window shade” and not specifically the “web” itself. In this case perhaps “web” should be deleted on line 5. However, if this is not the case the reference number in parenthesis following “web” should be changed to the correct corresponding number “(26)” for clarity. Finally, it should be noted that none of the previous claims appear to recite that either the “web” or the “shade” has a “completely retracted position”.

In claim 25, line 3, the limitation “their exterior circumferential surface” is recited. There is insufficient antecedent basis for this limitation in the claim.

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Claim 30 recites the limitation "the guide tubes" in line 3, "the drive motor" on line 4, and "the guide rails" in lines 4-5. There is insufficient antecedent basis for these limitations in the claim.

Claim 31 recites the limitation "the guide rails" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

18. Claims 1-2, 6, 8-9, 11-12, and 21-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Ojima et al.

Ojima et al. disclose a windup window shade for regulating the entry of light through a window 1, 2 into the interior of a motor vehicle, having at least one windup shaft 113 (Figure 1), seating means 11 in which the windup shaft is rotatably seated, connecting means 16, with which the seating means are connected with each other, wherein the connecting means is arranged to be attached to the motor vehicle, at least one window shade web 12, which is connected to the windup shaft with one edge, at least one pair of guide means 14, each one of which extends at least a distance away from a corresponding side of the window shade web and each of which

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contains at least one guide groove (Figure 16), a traction rod 13, which is connected with an edge of the window shade web 12 remote from the windup shaft 113 and whose ends, generally 17, are guided in the guide grooves (Figure 16), and a drive mechanism 15 for moving the traction rod along the guide rails and for driving the windup shaft. The windup shaft is tube-shaped and contains a spring drive 112, which is part of the drive mechanism. The window shade web 12 has been cut to approximate the window 1, 2. The guide means 14 are constituted by a guide rail 14, which contains an undercut groove (Figure 16). The guide means 14 extend in a manner corresponding to the associated edge of the window. The guide rail 14 is provided with at least one continuous surface, generally an upper surface of the backwards "C" in Figure 16, whose generatrix is a straight line extending at right angles with respect to the longitudinal axis of the guide rail. The guide rail 14 has two surfaces, generally an upper surface and a lower surface of the backwards "C" in Figure 16, which are parallel to each other and whose generatrices are straight lines extending at right angles with respect to the longitudinal axis of the guide rail. The traction rod 13 consists of a center piece 131 and two end pieces 132, which can be moved in a telescope-like manner in relation to the center piece, wherein ends 17 of the end pieces are displaceably movable in the respective guide rail. The drive mechanism 15 has at least two drive members 18a, 18b, which are arranged drivingly between an electric drive motor 20 and the traction rod 13. The drive members 18a, 18b, are thrust members. The drive members are linearly-shaped members. The drive members have teeth on their exterior circumferential surface, generally of the rack and pinion type. The drive mechanism has a gear motor 20, on whose

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output shaft a gear wheel 19 is seated, which acts together in an interlocked manner with the drive members 18a, 18b.

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

20. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ojima et al. as applied to claim 22 above, in view of DE '966.

Ojima et al. lack guide tubes extending from the drive motor as far as an end of a respective guide rail.

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DE '966 teach guide tubes 6, 7 for drive members 8, 9 which inherently extend from a drive motor 11 (Figures 10, 11, and 12) to an end of a guide rail 27 (Figure 4).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided guide tubes as taught by DE '966 upon the drive members of Ojima et al. in order to protect the drive members.

Allowable Subject Matter

21. Claims 3-5, 7, 10, 13-15, 20, and 28-31 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited references show other window shades similar to that of the current invention.

23. Any inquiry concerning this communication from the examiner should be directed to Hilary L. Gutman whose telephone number is (703) 305-0496.

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24. **Any response to this action should be mailed to:**

Assistant Commissioner for Patents

Washington, D.C. 20231

or faxed to:


(703) 305-3597, (for formal communications intended for entry)

or:

(703) 305-0285, (for informal or draft communications, please clearly label
"PROPOSED" or "DRAFT").

hlg

February 4, 2003


D. GLENN DAYOAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600
2/6/03